

REMARKS

Claims 1, 2 and 4-11 are pending in this application. By this Amendment, claim 11 is amended for form. Thus, no new matter is added.

I. Claim 10 Satisfies All Formal Requirements

The Office Action objects to claim 10 for informalities. Specifically, the Office Action asserts that in line 5, the pixel area should be defined by data lines and scanning lines instead of only data lines. By this Amendment, claim 10 is amended accordingly.

Withdrawal of the objection is thus respectfully requested.

II. Claim 1 Satisfies The Requirements Of 35 U.S.C. §112, First Paragraph

The Office Action rejects claim 1 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. This rejection is respectfully traversed.

The Office Action asserts that the claims are not enabled by the specification. Specifically, the Office Action asserts that specification does not disclose a second light shielding film disposed between the switching element and the liquid crystal at the region corresponding to the switching element but not the region corresponding to between the adjacent pixel areas. The Office Action relies on paragraph [0048] of the specification to assert that data line 6a is formed of a shading material, and disposed between the switching element TFT 30 and the liquid crystal at the region corresponding to the switching element 30, as shown in Fig. 2. These assertions are respectfully traversed.

The test for enablement is whether one reasonably skilled in the art could make or use the invention from the disclosure in the patent coupled with information known in the art, without undue experimentation. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988); see also MPEP §2164.01. First, paragraph [0013] of the specification recites "since the display defects caused by disclination are placed outside the pixels, a black matrix for shading an area in which the disclination is generated is not additionally provided."

That is, light shielding is not necessary between the adjacent pixel areas in the claimed invention. Second, support for the second light shielding film can be found at least at Figs. 2 and 3 of the instant application. Thus, the shielding film was in the possession of the inventor at the time of the invention.

Furthermore, the Office Action relies on paragraph [0048] of the specification as disclosing the shield film. However, paragraph [0048] merely describes Figures 4 and 5 and is not directed to the shield film.

Thus, claim 1 satisfies the requirements of 35 U.S.C. §112, first paragraph.

Withdrawal of the rejection is thus respectfully requested.

III. The Claims Define Patentable Subject Matter

A. Rejection of Claims 1 and 2

The Office Action rejects claims 1 and 2 under 35 U.S.C. §103(a) over U.S. Patent No. 5,818,550 to Kadota et al. in view of U.S. Patent No. 5,808,595, to Kubota et al., U.S. Patent No. 6,141,074 to Bos et al., U.S. Patent No. 6,313,898, to Numano et al., and U.S. Patent No. 6,160,535 to Park. This rejection is respectfully traversed.

Claims 1 and 2 would not have been rendered obvious by Kadota in view of Kubota, Bos, Numano and Park. There is no motivation to combine Kadota with Kubota, Bos, Numano and Park. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). See also, e.g., MPEP §2143.01. Further, "a statement that modifications to the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art at the time the claimed invention was made,' because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the

references." *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. and Inter. 1993). See, e.g., also MPEP §2143.01. However, "any judgment on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper." *In re McLaughlin*, 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971); see also MPEP §2145 (IX).

The Examiner merely included knowledge gleaned from Applicants' disclosure to assert that the combination of the five applied references discloses the LCD device recited in claim 1, and thus, used improper hindsight reasoning.

Furthermore, even if there is motivation to combine the references as suggested, the claimed invention still would not have been achieved. Specifically, Kadota does not disclose the claimed second light shielding film. Kadota, instead, only discloses a structure for thin film transistors that includes a conductive electrode 14 that is placed beneath a thin film. See, e.g., Kadota, Fig. 1, and col. 13, lines 25-46. More specifically, nowhere does Kadota teach or suggest a second light shielding film that is disposed between the switching element TFT and the liquid crystal at the region corresponding to the switching element, but not at the region corresponding to between adjacent pixels, as recited in claim 1. Furthermore, as acknowledged by the Office Action, none of the applied references remedy this deficiency.

Thus, for at least these reasons, claim 1 is patentable over Kadota, Kubota, Bos, Numano and Park. Further, claim 2, which depends from claim 1, is also patentable over Kadota, Kubota, Bos, Numano and Park, for at least the reasons discussed with respect to claim 1, as well as the additional features recited therein. Withdrawal of the rejection is thus respectfully requested.

B. Rejection of Claims 4, 5 and 8

The Office Action rejects claims 4, 5 and 8 under 35 U.S.C. §103(a) over Kadota in view of Kubota, Bos, Numano and Park and further in view of U.S. Patent No. 6,339,459 to Ichikawa et al. This rejection is respectfully traversed.

Claims 4, 5 and 8 would not have been rendered obvious by Kadota, Kubota, Bos, Numano and Park and further in view of Ichikawa. First, there is no motivation to combine, as discussed with respect to claim 1. Further, Ichikawa does not remedy the deficiencies of Kadota, Kubota, Bos, Numano and Park discussed with respect to claim 1. Ichikawa is only cited by the Office Action for its alleged teaching of using LCD device in workstations and televisions. Claims 4, 5 and 8 depend from claim 1. Thus, claims 4, 5 and 8 are patentable over Kadota, Kubota, Bos, Numano, Park and Ichikawa for at least the reasons discussed with respect to claim 1, as well as the additional features recited therein. Withdrawal of the rejections is thus respectfully requested.

C. Rejection of Claim 6

The Office Action rejects claim 6 under 35 U.S.C. §103(a) over Kadota in view of Kubota, Bos, Numano and Park, and further in view of U.S. Patent No. 5,092,664 to Miyatake et al. This rejection is respectfully traversed.

Claim 6 would not have been rendered obvious by Kadota in view of Kubota, Bos, Numano, Park and Miyatake. First, there is no motivation to combine, as discussed with respect to claim 1. Further, Miyatake does not remedy the deficiencies of Kadota, Kubota, Bos, Numano and Park discussed with respect to claim 1. Miyatake is only cited by the Office Action for its alleged teaching of a projection type display apparatus employing an LCD device. Claim 6 depends from claim 1. Thus, claim 6 is also patentable over Kadota, Kubota, Bos, Numano and Park for at least the reasons discussed with respect to claim 1, as

well as the additional features recited therein. Withdrawal of the rejection is thus respectfully requested.

D. Rejection of Claim 7

The Office Action rejects claim 7 under 35 U.S.C. §103(a) over Kadota in view of Kubota, Bos, Numano and Park and further in view of U.S. Patent No. 6,218,679 to Takahara et al. This rejection is respectfully traversed.

Claim 7 would not have been rendered obvious by Kadota in view of Kubota, Bos, Numano, Park and Takahara. First, there is no motivation to combine, as discussed with respect to claim 1. Further, Takahara does not remedy the deficiencies of Kadota, Kubota, Bos, Numano and Park discussed with respect to claim 1. Takahara is only cited by the Office Action for its alleged teaching of a projection type display apparatus employing a LCD device. Claim 7 depends from claim 1. Thus, claim 7 is patentable over Kadota, Kubota, Bos, Numano, Park and Takahara for at least the reasons discussed with respect to claim 1, as well as the additional features recited therein. Withdrawal of the rejection is thus respectfully requested.

E. Rejection of Claim 9

The Office Action rejects claim 9 under 35 U.S.C. §103(a) over Kadota in view of Kubota, Bos, Numano and Park and further in view of U.S. Patent No. 6,040,890 to Sawada et al. This rejection is respectfully traversed.

Claim 9 would not have been rendered obvious by Kadota, in view of Kubota, Bos, Numano, Park and Sawada. First, there is no motivation to combine, as discussed with respect to claim 1. Further, Sawada does not remedy the deficiencies of Kadota, Kubota, Bos, Numano and Park discussed with respect to claim 1. Sawada is cited by the Office Action for its alleged teaching of liquid crystal layer, as recited in claim 9. Claim 9 depends from claim 1. Thus, claim 9 is patentable over Kadota, Kubota, Bos, Numano, Park and Sawada for at

least the reasons discussed with respect to claim 1, as well as the additional features recited therein. Withdrawal of the rejection is thus respectfully requested.

F. Rejection of Claim 11

The Office Action rejects claim 11 under 35 U.S.C. §103(a) over Kadota in view of Kubota, Bos, Numano and Park and further in view of U.S. Patent No. 6,515,725 to Hattori et al. This rejection is respectfully traversed.

Hattori does not constitute prior art. Hattori is a U.S. National Stage of a PCT that has a PCT publication date of February 8, 2001. Thus, Hattori's U.S. effective priority date is February 8, 2001. However, the above-identified application claims priority to JP 2000-115270 filed April 17, 2000 and JP 2001-064073 filed March 7, 2001. A certified copy of the English translations were filed in this application on March 6, 2003, as acknowledged by the Office Actions. Because JP 2001-115207 supports the features of claim 11, Hattori does not constitute prior art.

Withdrawal of the rejection is thus respectfully requested.

G. Rejection of Claim 10

The Office Action rejects claim 10 under 35 U.S.C. §103(a) over Bos in view of Hattori and Park. This rejection is respectfully traversed.

As discussed with respect to claim 11, Hattori does not constitute prior art. Because JP 2000-115207 supports all of the features of claim 10, Hattori does not constitute as prior art.

Withdrawal of the rejection is thus respectfully requested.

IV. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



James A. Oliff
Registration No. 27,075

Randi B. Isaacs
Registration No. 56,046

JAO:RBI/brp

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OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

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